

REMARKS

Claims 1-38 are currently pending in the present application.

Claim Rejections – 35 USC § 101

In the Action, the Examiner rejects claims 29, 30-38 under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. According to the Examiner, the language “client *that executes* a . . . application having a series of instructions” is non-statutory software claim language. The Examiner also states that the claim language does not explicitly specify a software. The Applicants respectfully disagree.

Independent claims 29 and 30 are directed to a system for accessing data, comprising a client and an application server. Therefore, claims 29 and 30 are directed to a “machine” in the sense of 35 USC § 101 and are thus directed to patentable subject matter. See also pending claim 20, which is similarly worded and has not been rejected by the Examiner. The Examiner is respectfully reminded that utility of a claim under 35 USC § 101 must be assessed looking at the claim as a whole. See MPEP 2106 II.C when citing *Diamond v. Diehr*, 450 U.S. at 188-189, 209 USPQ at 9.

The language “*that executes*” of claims 29 and 30 refers to the mode of operation of the client and application server. Similarly to a computer that executes software code, the client of claim 29 executes “a Java applet”, the client of claim 30 executes “a first application”, the application server of claim 29 executes “a servlet”, and the application server of claim 30 executes “one or more applications.” Specification of the mode of operation of a client or server by referring to an application does not transform the claim to a software-per-se claim. To the contrary, specification of the mode of operation of a client or server defines a functional interrelationship between the applet/application and the client /server which permit applet/application’s functionality to be realized, and is thus statutory.

Further, claim 29 recites *"wherein the applet interacts with the database through the application server so that a security mechanism protecting the client does not interrupt the accessing of the data in the database"* and claim 30 recites *"wherein the client interacts with the database through the application server so that a security mechanism protecting the client does not interrupt the accessing of the data in the database."* Both recitations contain clear "useful, concrete and tangible results" (borrowing the language from *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601) that makes claims 29 and 30 statutory.

Therefore, the Applicants submit that independent claims 29, 30 and dependent claims 31-38 are statutory and in compliance with 35 USC § 101.

Claim Rejections – 35 USC § 102

In the Action, the Examiner rejects claims 1-38 under 35 USC 102(e) as being anticipated by U.S. Pat. App. Pub. 2002/0065946 A1 to Narayan. The Applicants respectfully disagree.

Effective date of Narayan

As a preliminary comment, the Applicants note that the October 6, 2001 filing date of Narayan is after the June 1, 2001 filing date of the present application. Therefore, in order to rely on Narayan, the Examiner should make reference not to Narayan itself, but to the provisional application Nos. 60/241,273 (filed on October 17, 2000) and 60/241,447 (filed on October 17, 2000) on which Narayan is based. Further, should the Examiner still maintain his objections and use the contents of the provisional applications against claims 1-38 of the present application, those provisional applications should also be made available to the Applicants, also in view of the fact that the contents of those provisionals are incorporated by reference in Narayan (see paragraphs [0001] and [0002] of Narayan).

The Applicant submits that the above comments already form a complete response and that the Examiner should respectfully issue a further non-final action based on and including the above cited provisional applications in case the Examiner believes that the 35 USC § 102 rejections of the present action are to be maintained.

Nevertheless, in the spirit of cooperation, and in order to speed up prosecution of the present application, the Applicants also offer the following substantive comments.

Claims 1-10

In section 4 of the Action, the Examiner provides arguments as to why Narayan anticipates claim 1. The Applicants respectfully disagree.

Claim 1 recites “[a]n apparatus for accessing data from a database . . . comprising . . . a first application . . . proxy objects requesting data from a database . . . one or more drivers . . . and a second application . . . generating a database query based on the proxy objects and the drivers and returning the database query to the first application” (emphasis added).

Narayan is a very long document (661 different paragraphs). The Applicants have performed a computer search on the electronic version of Narayan and have not been able to find a single recitation of the term “database” , let alone the features “requesting data from a database” of the proxy objects or the features “generating a database query” or “returning the database query to the first application” of the second application. In particular, none of the paragraphs [0006], [0020], [0021] and [0041]-[0647] recited by the Examiner contains recitation of database features. Apparently, the Examiner is making reference to paragraph [0529] of Narayan which, in turn, makes reference to bank information and credit card numbers. However, the mere recitation of such information is insufficient to provide an anticipation for the above recited features of claim 1. Should the Examiner disagree with the Applicants, the Examiner is respectfully requested to show with particularity to the Applicants where the above features of claim 1 are shown in Narayan, in accordance with 37 CFR § 1.104(c)(2), which requires an Examiner to designate a “particular part” of a complex reference “as nearly as practicable.” The

Applicants respectfully submit that the Examiner has failed to “designate as nearly as practicable” the particular part of Narayan in making a general reference to paragraphs [0041]-[0647].

Further, claim 1 recites a “*a second application capable of being executed on a server computer separated from the first application by a security mechanism . . . and returning results to the first application.*” Although the Applicants agree with the Examiner that Narayan cursorily mentions firewalls, the Applicants have not been able to find where, in Narayan, the above feature of claim 1 is disclosed. The Applicants note that a mere recitation of a component of the above feature does not anticipate the whole feature. Therefore, should the Examiner disagree with the Applicants, the Examiner is respectfully requested to show the “particular part” of Narayan showing the above recitation of claim 1.

Still further, claim 1 recites “*generating a database query based on the proxy objects and the drivers.*” In sharp contrast, Narayan does not disclose databases, let alone database queries or elements (such as the drivers and the proxy objects) on which those queries are based. Apart from repeating the language of the claims, the Examiner is just using terms such as ‘clearly’ and ‘inherently’ in combination with a generic reference to more than 600 paragraphs (!) of Narayan to assert that such feature is anticipated. The Applicants respectfully submit that this is not the right standard for anticipation and a more precise recitation of Narayan is required.

Therefore, the Applicants respectfully submit that claim 1 is novel over Narayan, together with claims 2-10, at least by virtue of their dependence on claim 1.

Claims 11-19

In section 4 of the Action (page 4), the Examiner rejects method claim 11 for substantially the same reasons used against claim 1. The Applicants respectfully disagree for substantially the same reasons as shown with reference to claim 1.

Therefore, the Applicants respectfully submit that claim 11 is novel over Narayan, together with claims 12-19, at least by virtue of their dependence on claim 11.

Claims 20-28

In section 4 of the Action (pages 4 and 5), the Examiner rejects method claim 20 for substantially the same reasons used against claim 1. The Applicants respectfully disagree for substantially the same reasons as shown with reference to claim 1.

Therefore, the Applicants respectfully submit that claim 20 is novel over Narayan, together with claims 21-28, at least by virtue of their dependence on claim 20.

Claims 29-38

In Sections 14 and 15 of the Action (pages 12 and 13), the Examiner rejects system claims 29 and 30 for substantially the same reasons used against claim 1. The Applicants respectfully disagree for substantially the same reasons as shown with reference to claim 1.

Therefore, the Applicants respectfully submit that claims 29 and 30 are novel over Narayan, together with claims 31-38, at least by virtue of their dependence on claim 30.

* * *

The Applicants submit that all claims of the application are in condition for allowance. Prompt issuance of a Notice of Allowance is earnestly solicited.

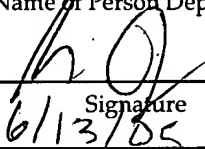
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Examiner: Baum, Ronald
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The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 on

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Suzanne Johnston
(Name of Person Depositing)


Signature

6/13/05
Date

Respectfully submitted,



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